



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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JUN 11 2003

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OFFICE OF THE DIRECTOR
TC 3600

In re Application of
John S. Bibb et al.
Application No. 09/587,544
Filed: June 5, 2000
For: PILOT HYDRAULIC CONTROL FOR
A PAIR OF STABILIZER LEGS ON A
BACKHOE LOADER MACHINE

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in response to applicants' petition under 37 CFR 1.183 to waive the rules under 37 CFR 1.134 filed in the United States Patent and Trademark Office (USPTO), on November February 10, 2003. That petition is being treated as a petition to withdraw the holding of abandonment.

The petition is **DISMISSED**.

A review of the file record reveals that a Final Office action was mailed to the applicants on April 30, 2002. A response was received on January 8, 2003. An Advisory action was mailed on January 10, 2003 wherein it was held that the January 8, 2003 response did not place the application in condition for allowance. The issuance of the Advisory Action, mailed January 10, 2003 was improper because at the time of its mailing, the application had already been abandoned for failure to timely file a proper reply to the Final Office action. That improper Advisory action of January 10, 2003 is hereby vacated. Although no formal Notice of Abandonment has yet been mailed, the case is in fact abandoned since the period for responding has expired.

On February 10, 2003, applicants filed a petition under 37 CFR 1.183 to waive the rules under 37 CFR 1.134. In the petition, applicants argue that the Advisory action, mailed January 10, 2003, set the period for reply to expire three months from the mailing date of the final rejection. Due to the fact that the final rejection was mailed July 30, 2002, it would be impossible to submit a reply to the Advisory action given that 37 CFR 1.134 sets the maximum period for reply at six months. Applicants request that the period for reply for the Advisory action be set from the mailing date of the Advisory action and not the Final rejection. Since the issuance of the Advisory Action, mailed January 10, 2003 was improper and vacated, applicants' request is moot.

The communication filed February 10, 2003 is being treated as a petition to withdraw the holding of abandonment. In the petition applicants argue that a response to the Final Office action was filed on July 25, 2002. There is no evidence in the file record of the Office having received any such response. A copy of the reply was provided on January 8, 2003 in response to the examiner's January 7, 2003 telephone call noted in the petition. The response includes a Certificate of Mailing dated July 25, 2002. However, a statement, by the person who signed the statement, attesting to the personal knowledge of mailing the response on the date indicated on the Certificate of Mailing is required (37 CFR 1.8(b)(3)). If applicants provide the necessary statement and the petition to withdraw the holding of abandonment is granted, the application will be forwarded to the examiner for consideration of the response filed July 25, 2002. However, it appears that the examiner did not consider the response sufficient to place the application in condition for allowance, as noted in the vacated Advisory action. If the examiner again considers that the response does not place the application in condition for allowance, the application will again be held to be abandoned since a proper reply under 37 CFR 1.113 to the Final Office action was not filed before the expiration of the six-month statutory time period for reply.

MPEP 714.13 sets forth the expedited procedure for processing amendments and other replies after final rejection (37 CFR 1.116). In any application in which a reply under this procedure has been filed and no action by the examiner has been received within the time referred to therein, plus normal mailing time, a telephone call to the supervisory patent examiner (SPE) of the relevant TC art unit would be appropriate in order to permit the SPE to determine the cause for any delay. It appears that applicants made no such call to the SPE. Had applicants telephoned the SPE, applicants would have been informed that the Office had not received the July 25, 2002 response. Thus, applicants would have been able to resubmit the July 25, 2002 response, or another proper reply under 37 CFR 1.113 prior to the expiration of the six-month statutory period for reply.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Since applicant's petition to withdraw the Holding of Abandonment will not be granted applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional

application abandoned for failure to prosecute; (2) the petition fee required by 37 CFR 1.17(l); and (3) an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II Unintentional Delay.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (2) the petition fee required by 37 CFR 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is \$110. The fee for a petition under the unintentional standard is \$1,300. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

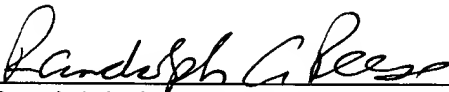
Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Deputy Commissioner of Patent Examination Policy
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
Attn: Office of Petitions

By Hand: Crystal Plaza 4, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Please contact me directly for inquiries specific to this decision.



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RAR/tpl: 6/9/03